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In re Application of LINIAL et al
U.S. Application No.: 09/601,278
Int. Application No.: PCT/IL99/00057
Int. Filing Date: 29 January 1999
Priority Date: 29 January 1998
Attorney Docket No.: P-1476-US
For: AN AUTOMATIC METHOD OF
CLASSIFYING MOLECULES

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This is in response to applicants' "A Second Renewed Petition Under 37 C.F.R. 1.47(a)" filed 04 April 2002, requesting that the present application be accepted for United States national stage processing without the signature of one of the four joint inventors.

BACKGROUND

On 29 January 1999, applicants filed international application PCT/IL99/00057, which claimed priority of an earlier United States application filed 29 January 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 05 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 31 July 2000 (29 July 2000 was a Saturday).

On 31 July 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, authorization to charge the requisite basic national fee required by 35 U.S.C. 371(c)(1) and an unsigned declaration.

On 22 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 22 February 2001, applicants filed a petition under 37 CFR 1.47(a) along with a declaration signed by three of the four joint inventors and not signed by inventor Golan Yona.

On 12 June 2001, this Office mailed a decision dismissing the 22 February 2001 petition.

On 13 August 2001, applicants filed a renewed petition under 37 CFR 1.47(a).

On 04 October 2001, this Office mailed a decision dismissing the 13 August 2001 renewed petition.

On 04 April 2002, applicants filed the present renewed petition.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicants have previously satisfied items (1), (3), and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have demonstrated that a bona fide attempt was made to present a copy of the complete application papers to the nonsigning inventor Golan Yona for signature. Specifically, a copy of the application papers was sent to Yona on 16 December 2001 (see affidavit of Renee Ben-Israel, ¶15 and Exhibit 10). Receipt of the application papers has been confirmed (see Ben-Israel's affidavit, ¶16 and Exhibit 11). Furthermore, applicants have shown that repeated attempts to obtain Yona's signature have failed (see Exhibits 3, 4, and 11). Therefore, it can be concluded with reasonable certainty that Yona refuses to join in the application.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(a) is GRANTED.

This application has an international filing date of 29 January 1999 and a date under 35 U.S.C. 371 of 22 February 2001.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



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APR 23 2002

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Dear Golan Yona:

You are named as a joint inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you choose to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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